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IHW

Docket: 14602.01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|             |                              |           |         |
|-------------|------------------------------|-----------|---------|
| Applicant:  | Daniel T. Johnson            | Examiner: | Unknown |
| Appln. No.: | 10/768,957                   | Group Art |         |
| Filed:      | January 30, 2004             | Unit:     | 2121    |
| Title:      | Enterprise Management System |           |         |

**RESPONSE TO DECISION ON PETITIONS UNDER 37 C.F.R. 1.78(a) AND  
UNDER 37 C.F.R. 1.78(a)(6)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this document is being sent via First Class U.S. mail  
addressed to Mail Stop Petition Commissioner for Patents, P.O. Box 1450,  
Alexandria, VA 22313-1450, on this 8 day of February, 2005.

Francesco Orsini  
Signature

Sir:

In response to the Decision on Petitions under 37 C.F.R. 1.78(a) and under 37 C.F.R. 1.78(a)(6), mailed on December 2, 2004, (copy enclosed), Applicant submits herewith a Request to Amend the Specification along with a Preliminary Amendment which accurately relates the relationship for the claim for priority in the above-identified patent application, and a new Application Data Sheet.

Applicant previously submitted the appropriate fee of \$1330.00 as required under 37 C.F.R. 1.17(t), and believes that no additional fees are necessary for the acceptance of the Petition to Correct Priority Claim. However, the Commissioner is hereby authorized to charge any deficiencies and/or credit any overpayments to Deposit Account No. 04-1420.

Respectfully submitted,

DORSEY & WHITNEY LLP  
Customer Number 25763

Date:

February 8, 2005

By:

Sean D. Solberg  
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DEC 06 2004

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OFFICE OF PETITIONS

**DOCKETED**

In re Application of  
Daniel T. Johnson et al  
Application No. 10/768,957  
Filed: January 30, 2004  
Attorney Docket No. 14602.01

MR : DECISION ON PETITIONS  
: UNDER 37 CFR 1.78(a)(3) AND  
: UNDER 37 CFR 1.78(a)(6)  
:

This is a decision on the petition filed July 21, 2004, which is being treated as both a petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petitions are **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition fails to comply with item (1) above.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation,

divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., (August 2001), Section 201.11, Reference to First Application. The amendment filed July 21, 2004 does not state the relationship of the prior-filed applications to the instant application.

Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) and a substitute amendment<sup>1</sup> which sets forth the relationship of each of the prior-filed applications is required.

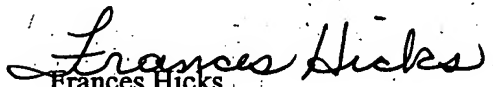
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS  
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By hand: Customer Window located at:  
U.S. Patent and Trademark Office  
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Crystal Plaza Two Lobby, Room 1B03  
Arlington, VA 22202

By fax: (703) 872-9306  
ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.

  
Frances Hicks  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup> Note 37 CFR 1.121